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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590 01/28/2005
ABELMAN FRAYNE & SCHWAB
150 East 42nd Street
New York, NY 10017

EXAMINER

JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,643

Applicant(s)

DAR ET AL.

Examiner

Romain Jeanty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23,24,26,27,43-45,56-58 and 64-93 is/are pending in the application.
- 4a) Of the above claim(s) 1-22,25,28-42,46-55 and 59-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-24, 26-27, 43-45, 56-58, and 64-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This Final Office Action is in response to the Amendment filed October 18, 2004. In the amendment, claims have been amended, claims 1-22, 25, 28-42, 46-55, 59-63 have been cancelled. New claims 64-93 have been added. Claims 23-24, 26-27, 43-45, 56-58, and 64-93 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 23, 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not readily understood to the examiner as to how this durable absent the non-dependency of the input .

Claims 26-27, 43, 57-58, 65, 70, 74, 76, 79, 84, and 91 depend on independent claims 23 and 56; and therefore are rejected under the same rationale relied upon claims 23 and 56.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 24, 44-45, 64, 66-69, 71-73, 75, 77-78, 80-83, 85-90, and 92-93 are rejected under 35 U.S.C. 102(b) as being anticipated over by Hirshberg (U.S. Patent No. 5,289,369)

As per claims 24, 44, 64, 66-67, 69, 75, 77-78, 80-83, 85-90, and 92-93, Hirshberg discloses a car rent system comprising: at least one sensor on-board a vehicle and automatically sensing at least one of the time during which said vehicle is being operated and where said vehicle is located when it is being operated (col. 2, lines 43-47); at least one communicator on-board said vehicle providing an output indicating at least one of the time during which said vehicle is being operated and where said vehicle is located when it is being operated (col. 4, lines 30-51); and at least one data processor receiving a communication from said at least one communicator, indicating at least one of the time during which said vehicle is being operated and where said vehicle is located when it is being operated and providing a billing data output in respect of a vehicle-related service which is dependent only on at least one of the time during which said vehicle is being operated and where said vehicle is located when it is being operated col. 2, lines 28-42).

As per claims 24, 77-78, 80-83, 86-90, and 92-93, Hirshberg discloses a car rent system comprising:

a sensor on-board a vehicle and automatically sensing only at least one of the time during which said vehicle is being operated (col. 2, lines 43-47); at least one communicator on board said vehicle providing an output indicating the time during which said vehicle is being operated; and; at least one data processor receiving a communication from said at least one

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communicator, indicating at least one of the time during which said vehicle is being operated (col. 2, lines 43-47 and col. 4, lines 30-51), and providing a billing data output in respect of a vehicle-related service which is dependent on at least one of the time during which said vehicle is being operated (col. 2, lines 38-42).

As per claim 45, Hirshberg further discloses wherein said intermediate storage and communication unit is located at a vehicle fueling station (col. 5, lines 27-33).

As per claims 71-73, Hirshberg further discloses wherein said intermediate storage and communication unit is located at a vehicle fueling station (col. 4, lines 39-51).

As per claim 68, Hirshberg further discloses wherein said communicator communicates with an intermediate storage and communication unit only when a vehicle in which said communicator is located is at one of a plurality of predetermined locations determining the location of the vehicle in real-time) (col. 5, lines 27-33).

Response to Arguments

6. Applicant's arguments filed October 18, 2004 have been fully considered but they are not persuasive.

Remarks

Claims 23 and 56, Applicant has argued that claim 23 has been amended to recite that the billing data output is dependent on the time which said vehicle is being operated and is not dependent on any other input received from a vehicle-mounted sensor. In response, the examiner respectfully disagrees and applicant is directed to the rejection in paragraph number 3.

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In response to applicant's argument of claim 64 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "providing a billing data in *respect of a vehicle-related insurance fee* which is dependent on the time during which said vehicle is being operated") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Romain Jeanty". The signature is stylized with a large, looped initial "R".

Romain Jeanty

Primary Examiner

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January 24, 2005